

REMARKS

Claims 1-7 and 9-66 are pending in the application.

Claims 1-7 and 9-66 have been rejected.

Claims 29, 31, 35, 48, 52 and 61 have been amended solely to correct one or more informalities in the claim language.

Claims 49-51 and 57-60 have been canceled, without prejudice.

Reconsideration of the Claims is respectfully requested.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claims 57-60 were rejected under 35 U.S.C. § 102(e) as being anticipated by Farris (US 6,064,653). The rejection is respectfully traversed. However, Applicant has canceled Claims 57-60, without prejudice.

II. **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-7, 12-14, 18-44, 48-56 and 61-66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Farris (US 6,064,653) in view of Forslow (US 6,608,832). Claims 9-11 and 45-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Farris (US 6,064,653) in view of Forslow (US 6,608,832), and further in view of Dutnall (US 6,584,098). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references

when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Independent Claims 1, 27, 31, 48, 52, 61 and 63 (method, medium, system or apparatus) recite, generally, (1) determining the importance of a plurality of time sensitive communications (or telephone call transmissions) and (2) switching an in-progress time sensitive communication (or existing telephone call) from one type communication path to another type communication path based on the determined importance of the communication if/when the quality of transmission (over the one type communication path) is not acceptable or does not meet certain criteria.

Independent Claims 18, 29, 35 and 65 (method, medium or apparatus) recite, generally, (1) identifying in-progress time sensitive communications (or existing telephone calls) that can be switched from the second type communication path to the first type communication path and (2) switching one of the identified communications (or calls) from the second type communication path to the first type communication path if the quality of the transmission (over the first type communication path) is acceptable or meets certain criteria.

The Office Action concedes that Farris does not disclose such elements/features. See, Office Action, pp. 10-12. The Office Action then asserts that Forslow discloses such elements/features and, therefore, it would be obvious to modify Farris in order to provide better service for different types of applications. See, Office Action, pp 12-14.

Forslow recites individual application flows (communications) selecting (1) QOS parameters and (2) type of transfer mechanism (either circuit-switched or packet-switched). Col. 7, lines 38-41. However, the selection and allocation of the circuit-switched or packet-switched method of transmission is performed prior to the actual communications. See, Col. 5, line 22 thru Col. 7, line 2, and (“For each application flow, a determination is made whether a circuit-switched or a packet-switched bearer *should be established*”, Col. 5, lines 58-60). As such, Forslow is not directed to, or applicable for, or even mentions, the switching of “in-progress” communications from one path to another when the quality of transmission on one path is unacceptable. In fact, Forslow merely selects one communication path from another based upon the type of service requested by the application flow. Col. 5, line 66 thru Col. 6, line 3. No switching of a communication from one path to the other is disclosed, taught or suggested.

Moreover, the cited passages of Forslow (col. 5, lines 10-21; Col 6, lines 16-33; col. 24, lines 10-24; and col. 7, lines 38-52) fail to disclose, teach or suggest determining the importance of a plurality of time sensitive communications and prioritize switching the communications from a first communication path to a second communication path based on the determined importance of the time sensitive communications. While Forslow refers only generally to quality of service (QOS) in Col. 56, lines 10-21 (“In the context of providing quality of service (QoS) in a mobile data communications systems . . .”), Forslow’s QOS or criteria is limited to use in the establishment of which communication path (circuit-switched or packet-switched)

should be set up for the communication flow. Forslow does not determine the importance of the communications and then use this importance to switch the ongoing communication from one path type to another.

Because Forslow is limited to determining whether a circuit-switched path or packet-switched path will be used for a communication, and once determined, sending the communication over the selected path, even the combination of Forslow with Farris will not produce Applicant's claimed invention. Forslow would merely provide Farris with an initial determination of which communication path to use prior to initial communication. This does not cure Farris' deficiency of determining the importance of the plurality of time-sensitive communications and switching an in-progress communication from a first path to another path based on the determined importance of the communication when the quality of transmission on the first path is unacceptable.

Therefore, the proposed Farris-Forslow combination does not disclose, teach or suggest Applicant's invention, as claimed.¹

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections of Claims 1-7, 9-56 and 61-66.

¹ For the same reasons, the rejection of dependent Claims 9-11 and 45-47 further over Dutnall cannot stand, as the Farris-Forslow combination fails to provide a prima facie case of obviousness over the other claims.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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